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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,299	03/06/2002	Yusaku Fujii	1075.1192	8168
21171	7590	06/19/2007		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER WINTER, JOHN M	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 06/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/091,299	<b>Applicant(s)</b> FUJII, YUSAKU	
	<b>Examiner</b> John M. Winter	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☒ Claim(s) 6-50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the limitation “electronic information body...” this limitation is vague and indefinite, no limitation is imposed upon the claimed invention.

These claims also recite the limitation “valuable information...” this limitation is vague and indefinite, no limitation is imposed upon the claimed invention since the “value” of information is arbitrary.

These claims also recite the limitation “the consideration necessary...” this limitation is vague and indefinite, no limitation is imposed upon the claimed invention since the mere consideration of an element is intangible.

Claim 2 recites the feature “confirmably from the outside” since the “electronic information body” has no real physical embodiment it is unclear how it could be observed from a physical point of view (eg inside, outside etc...)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sixtus (US

Patent 5,903,721) in view of Aieta et al. (US Patent 6,839,689)

As per claim 1,

Sixtus ('721) discloses an electronic settlement method for electronically paying the consideration necessary for a commercial transaction by a receiver to a supplier via a settlement service provider upon the transaction between the receiver and the supplier, said method comprising the steps of:

obtaining and possessing an electronic information body for transmission of valuable data by the supplier, the electronic information body having a function of holding the valuable data and being recorded therein information for authentication required for authenticating a payee of the valuable data in advance; obtaining the electronic information body, which is owned by the supplier, by the receiver (hereinafter referred to as "obtaining step");(Column 3, lines 28-47)

transmitting the electronic information body from the receiver to the settlement service provider to request to attach valuable data having a value corresponding to the consideration necessary for the transaction to the electronic information body (hereinafter referred to as "requesting step");(Column 3, lines 28-47)

attaching the valuable data to the electronic information body at the request of the receiver after authenticating the receiver by the settlement service provider (hereinafter referred to as "attaching step");(Column 3 , line 27 through column 4 line 17)

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returning electronic information for transmission of valuable data composed of the electronic information body and the valuable data from the settlement service provider to the supplier (hereinafter referred to as "returning step");(Column 3 , line 27 through column 4 line 17)

Sixtus ('721) does not explicitly disclose transferring the proprietary right of the valuable data in the electronic information for transmission of valuable data to a candidate for the receipt of the valuable data by the settlement service provider only when the candidate has been authenticated as a payee oneself of the valuable data on the basis of the information for authentication stored in the electronic information body (hereinafter referred to as "proprietary right transferring step"). Aieta et al. ('689) discloses transferring the proprietary right of the valuable data in the electronic information for transmission of valuable data to a candidate for the receipt of the valuable data by the settlement service provider only when the candidate has been authenticated as a payee oneself of the valuable data on the basis of the information for authentication stored in the electronic information body (hereinafter referred to as "proprietary right transferring step") (Abstract) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Sixtus ('721) method with the Aieta et al. ('689) method in order to prevent fraudulent transactions.

As per claim 2

Sixtus ('721) discloses the method according to claim 1,

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wherein issuer information as to the issuer of the electronic information body is stored in advance in the electronic information body confirmably from the outside. (Column 3 , line 27 through column 4 line 17)

As per claim 3

Sixtus ('721) discloses the method according to claim 1,

wherein the valuable data is attached to the electronic information body confirmably from the outside. (Column 3 , line 27 through column 4 line 17)

As per claim 4

Sixtus ('721) discloses the method according to claim 1,

4. The method according to claim 3, wherein in the returning step, the electronic information is returned to the supplier via the receiver. (Figure 2)

As per claim 5

Sixtus ('721) discloses the method according to claim 1,

5. The method according to claim 3, wherein in the returning step, the electronic information is returned to the supplier via at least one third party other than the receiver registered in advance. (Figure 2)

***Allowable Subject Matter***

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Claims 6-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and overcome the rejection under 35 USC 112..

### ***Conclusion***

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that Nathan J. Muller's Desktop Encyclopedia of the Internet, ("Desktop Encyclopedia") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Muller's Desktop Encyclopedia is a practical reference that clearly explains Internet services, applications, protocols, access methods, development tools, administration and management, standards, and regulations. Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Desktop Encyclopedia is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this

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art must—at the very least—be aware of and understand the knowledge and information contained within the Desktop Encyclopedia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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